



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Wilson, James D..

Examiner: Brahon, Thomas J.

Serial No.: 10/798,708

Group Art Unit: 3654

Filed: March 11, 2004

Date:

For: THE DETECTING WHEEL CHOCK APPARATUS

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.181

Sir:

Applicants file this Petition to invoke the supervisory authority of the Director pursuant to 37 C.F.R. §1.181, regarding the prematurity of a final rejection. The following sections are included in this Petition:

Statement of Facts begins on page 2 of this Petition.

Point to be Reviewed begins on page 3 of this Petition.

Action Requested begins on page 4 of this Petition.

Memorandum in Support begins on page 5 of this Petition.

Statement of Facts

The instant application was filed on March 11, 2004. A non-final Office Action was mailed on October 6, 2005, and in that Office Action, the Examiner rejected Claims 1, 4-6 and 8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,824,536 issued to Cherico in view of U.S. Patent No. 6,781,516 issued to Reynard, et al. Applicants fully responded to the non-final Office Action in their Response A mailed on March 22, 2006.

A final Office Action was mailed on June 13, 2006. However, in the June 13, 2006 Office Action, Claims 1 and 4-6 were rejected for the first time under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,336,527 issued to Metz ("the '527 Patent") in view of U.S. Patent No. 5,457,838 issued to Geldon ("the '838 Patent"). Claims 1,2, and 4-6 were also rejected for the first time under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,276,496 issued to Hageman ("the '496 Patent) in view of U.S. Patent No. 6,033,174 issued to Alexander ("the '174 Patent).

Point to be Reviewed

Applicants respectfully submit that the June 13, 2006 Office Action was prematurely designated as final, since the Examiner relied on the '838 Patent and the '174 Patent for the first time in making a rejection based on those references.

Action Requested

Applicants respectfully request that the Director withdraw the finality of the rejection set forth in the June 13, 2006 Office Action.

Memorandum in Support

Applicants initially note that they are aware that it is desirable to raise the prematureness of the rejection with the Examiner. Applicants shall do so in a Response to the June 13, 2006 Office Action, which will be filed shortly. In addition, Applicants have provided a courtesy copy of this Petition to the Examiner. Applicants have filed this Petition before the mailing of their Response to the June 13, 2006 Office Action to comply with the two-month time for the filing of a Petition set forth in 37 C.F.R. §1.181(f).

Turning now to the basis for this Petition, the Examiner had relied on the '794 Publication for prior rejections, and switched to the '838 and '174 Patent for the final rejection in the Office Action mailed on June 13, 2006, relying on the '838 and '174 Patents for the first time. Applicants respectfully submit that the finality of the rejection based on the '838 and '174 Patents is premature, and therefore the finality of the Office Action should be withdrawn.

Applicants believe that the finality of the rejection is premature for the following reasons. First, as noted in MPEP §706.07(a), actions on the merits shall be made final "except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" (emphasis added). Applicants argue that the Examiner's introduction of the '838 and '174 Patents, which previously were not utilized as a ground of rejection in prosecution of the instant application, was not necessitated by Applicants' submission of an IDS or amendment of the claims. First, Applicants did not submit a new IDS between the time of the prior Office Action mailed on March 22, 2006 and the instant Office Action mailed on June 13, 2006. Second, as to Applicants' latest amendment of the claims in their Response "A" mailed on March 22, 2006, and in particular, to the amendment made to independent Claim 1, the

amendment merely was filed to *clarify* the claims. Thus, Applicants respectfully submit that such a clarifying amendment did not trigger the new ground of rejection. Therefore, on this basis alone, Applicants request the Director to withdraw the finality of the rejection as permitted under MPEP §706.07(d).

For the following additional reasons, either standing alone or in combination with each other and/or the reasons set forth above, Applicants believe that the Director should withdraw the finality of the rejection.

First, MPEP §706.07 sets forth the issues an Examiner should consider before making a rejection final: “Before final rejection is in order, a clear issue should be developed between the examiner and applicant” (emphasis added). This was not done in the instant prosecution. The fact that the Examiner raised a new ground of rejection based on the ‘838 and ‘174 Patents for the first time in the June 13, 2006 Office Action shows that a clear issue has not been developed as required by MPEP §706.07. Again, for this reason alone, the finality of the rejection should be withdrawn.

In addition, MPEP §706.07 goes on to state “Switching...from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will likely tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, *i.e.*, either an allowance of the application or a final rejection.” The Examiner clearly has violated this “switching” principle. In all prior Office Actions, the Examiner has relied on other prior art references, and Applicants made arguments respecting the those in their response: Response “A” (mailed on March 22, 2006). Then, in the second Office Action, the Examiner now has “switched” to the ‘838 and ‘174 Patents, despite the fact that the subject matter of the claims has remained substantially the same throughout this prosecution. In

so doing, the Examiner has likely extended the prosecution rather than directing it to early termination.

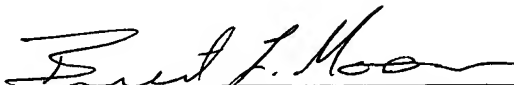
As further noted in MPEP §706.07, “present practice does not sanction hasty and ill-considered final rejections,” but that “the applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his or her application” (emphasis added). Applicants strongly believe that they have been prematurely cut off in the prosecution of this application by having a new ground of rejection, *i.e.*, the ‘838 and ‘174 Patents, raised for the first time and applied without basis for a rejection under 35 U.S.C. §103(a), particularly when Applicants merely amended the Claim 1 to clarify the subject matter. Applicants believe that this action on the part of the Office clearly is not in keeping with the spirit, if not the letter, of the “cooperation” and aversion to premature “cut off” addressed in MPEP §706.07.

MPEP §706.07 also warns that examiners “should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.” Again, raising a new ground of rejection using the ‘838 and ‘174 Patents clearly ignores this warning, as well as the MPEP admonition that grounds of rejection be “clearly developed to such an extent that applicant may readily judge the advisability of an appeal.” MPEP §706.07.

In summary, Applicants respectfully request the Director to withdraw the finality of the rejection in the June 13, 2006 Office Action and allow the claims as they stand, including Claims 1-8.

Respectfully submitted,

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Docket No.: HEND-AI-REG (45007-144)
«CT2:511044_v1»